



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,378	06/29/2006	Mark H Kaplan	50425/223	1608
1912 7590 03/05/2008 AMSTER, ROTHSTEIN & EBENSTEIN LLP 90 PARK AVENUE NEW YORK, NY 10016				
EXAMINER				
CHUNDURU, SURYAPRABHA				
ART UNIT		PAPER NUMBER		
1637				
MAIL DATE		DELIVERY MODE		
03/05/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/535,378

Applicant(s)

KAPLAN, MARK H

Examiner

Suryaprabha Chunduru

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 13, 16, 19, 20, 22, 24-27, 34, 41, 72 and 119-123 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 13, 16, 19, 20, 22, 24-27, 34, 41, 72 and 119-123 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-846)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Applicants' response to the office action filed on December 17, 2007 has been considered and acknowledged.

Status of the application

2. Currently claims 1, 2, 13, 16, 19-20, 22, 24-27, 34, 41, 72, 119-123 are pending. Applicants' arguments and the amendment have been fully considered and deemed persuasive in-part for the reasons that follow. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. This action is made FINAL.

Response to arguments:

3. With regard to the informalities, Applicants' arguments have been fully considered and found persuasive and the informalities are withdrawn. However, these informalities are noted while reviewing the specification and Examiner reiterates that these informalities are not objections.

4. With regard to the rejection of claims 1-2, 13, 16, 19-20, 34-35, 72, 119-123 under 35 USC 102(b) as being anticipated by Chang et al., Applicants' arguments and amendment were fully considered and found unpersuasive. The amendment did not overcome the rejection since the limitations in the instant claims 'a portion of an intron, and wherein the cDNA is at least 20 nucleotides long (in claim 1) or at least 50- 500 nucleotides long (in claims 25-27)' still read on the sequences as disclosed by Chang et al., because 'a portion' could comprise any fragment of two or more nucleotides. Further the cDNA nucleotide sequence as disclosed by Chang et al. has more than 500 nucleotides complementarity to the claimed SEQ ID NO. 10 and fully complementary to SEQ ID Nos. 11, 13, 15, thus the claims as recited are anticipated by the disclosure of Chang et al. and therefore the rejection is maintained.

5. With regard to the rejection of claim 41, under 35 USC 103(a) as being obvious over Chang et al. in view of Lowe et al. Applicants' arguments and the amendment have been fully considered and found unpersuasive. As discussed above the amendment did not overcome the rejection under 35 USC 102(b) and it would be obvious to modify the teaching of Chang et al. in view of Lowe et al. to generate PCR primers or primer pairs from known sequences. The rejection is maintained.

6. With regard to the rejection of claims 1-2, 13, 16, 19-20, 24-27, 34-35, 41, 72, 119-123 under 35 USC 112, first paragraph (written description), Applicants' arguments and amendment are fully considered and found unpersuasive. The claims recite 'a portion of' and 'cDNA is at least 20 nucleotides or 50 or 100 or 500 nucleotides', which encompass variants, fragments of any degree of homology including by permutations and combinations deletions, substitutions or insertions, for which the instant specification lacks support. Therefore the rejection is maintained.

Conclusion

No claims are allowable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Suryaprabha Chunduru/

Primary Examiner, Art Unit 1637